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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/316,795 | 05/21/1999 | RONALD P. SANSONE | E-846 | 8309 |

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EXAMINER

PWU, JEFFREY C

| ART UNIT | PAPER NUMBER |
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3628

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/316,795

Applicant(s)

SANSONE ET AL.

Examiner

Jeffrey Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 6-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al. (Boies hereinafter: US PAT. 6,006,200) in view of Allum et al. (Allum hereinafter: US PAT. 5,420,403).

Boies discloses a method of forwarding mail (i.e., a package delivered by U.S. Postal Service) that is addressed to a recipient (i.e., "a customer") and a virtual post office box (i.e., "a unique identifier to the customer") to be delivered directly to a recipient without the recipient going to the post, said method comprises the steps of:

receiving recipient's name and information regarding recipient's desired delivery address (this step would have been inherent in the database owned by the shipping company and to generate the unique identifier to the customer);

assigning a virtual post office box identification for individual recipients (see column 2, line 12, "to supply a unique identifier to the customer");

relating recipient's virtual post office box with recipient's desired delivery address of the recipient ("The method used in this invention is to employ a third party vendor to supply a unique identifier to the customer that maps to the customer's name and address in a database owned by the third party. The personal identifier is a multi-digit numeric or alphanumeric code assigned to a customer, as indicated at 10. This code is an accepted field by the vendor 12 that is used for shipping purposes. The shipper 14 is the creator and custodian of the codes. It generates a unique code for each customer, which code is associated with the customer's full

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shipping address and, optionally, the customer's name, permitting shipment to be made to the customer 16. (4) The association is maintained as a private database by the delivery organization. The shipper has an agreement with the customer not to sell its database codes and addresses to outside marketing organizations. The shipper also has an agreement with vendors to use this code with all shipping requests. When the vendor sends a package to the shipper, it is sent with this code for processing.”);

delivering to recipients their assigned virtual post office box's identification (col. 2, line 12, “to supply a unique identifier to the customer”);

placing virtual post office boxes on the mail (col. 2, lines 55-60);

reading mail to capture virtual post office box identification, when present (see column 2, lines 60-64);

determining recipient's desired delivery address from virtual post office box information and recipient's name (col. 2, lines 18-22 and 60-64);

determining in one or more data bases that recipients name is listed with recipient's desired delivery address and is the address to which the owner of the virtual post box wants the email forwarded, wherein the forwarding information may be sent by telephone, physical mail, or facsimile (“The process is illustrated in more detail in FIGS. 2A, 2B and 2C, to which reference is now made. A transaction begins at block 201 with the user wanting a product that cannot be sent electronically, i.e., over the Internet. An initial determination is made in decision block 202 as to whether the user has an address code. If not, the mailing address information is collected from the user in function block 203. Next, in function block 204, the registry is contacted to obtain an address code. This routine is shown in more detail in FIG. 2B and begins with validating the address in function block 205. An address code is assigned in function block 206, and this code is saved in function block 207 to the shipping company's master file database 208 before a return is made in function block 209 to the main routine in FIG. 2A where the code is displayed and saved to the user's computer in function block 210. (6) Referring again to FIG. 2A, once the user has an address code then a determination is made in decision block 211 as to whether the address code is available. If not, the user is prompted to enter the address code in

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function block 212; otherwise, the code is directly retrieved from the user's hard disk in function block 213. The address code is added to the order form in function block 214, and the order is submitted in function block 215. (7) Referring now to FIG. 2C, when the vendor receives the order, the vendor optionally creates a printed, machine readable representation of the address code on the shipping label in function block 216. The address code is printed to on the shipping label in function block 217, and the package is sent to the shipping company in function block 218. The shipping company uses the machine readable address code printed on the shipping label to access the master file 208 (FIG. 2B) to retrieve the user's shipping address for delivery of the package.”);

delivering the mail to the desired delivery address of the recipients (see column 2, lines 60-64).

Re claim 1: Boies does not explicitly disclose the steps of placing recipient's desired delivery address on mail in coded form and human readable form. However, Allum discloses the use of coded form, human readable form or both to print a delivery label (see FIGS. 7 and 8) to facilitate the routing of the mail automatically and to assist a delivery person to find correct delivery addresses. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Boies by adopting the teachings of Allum to facilitate the routing of the package automatically and to assist a delivery person to find correct delivery addresses.

Re claim 6: Boies further discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions (see claim 5).

Re claim 7: Boies does not explicitly disclose the changing step that further includes recipient specifies the time period in which mail is going to be delivered to the desired delivery address. However, it is old and well-known practice to specify the time period in which mail is going to be delivered to the changed delivery address (e.g., when someone is on vacation, it has been a common practice to notify the Post Office to reroute the mail to a next neighbor or hold until the person comes back from the vacation), and nothing unobvious is seen to have been

involved simply having employed this old and well-known practice for the claimed method to facilitate the mail delivery.

Re claims 8, 9 and 10: Boies does not explicitly disclose the step of billing for the number of times (or metering) recipient's changed their desired delivery address. However, it is a fundamental practice to charge any viable services including the claimed service in the art to obtain higher profit. Thus, it would have been within the level of ordinary skill in the art to employ this fundamental practice to the claimed method to increase the profit.

Re claim 11: Boies further discloses that the recipient's virtual post office box is represented in alphanumeric characters (see column 2, lines 14-16).

Re claims 12 and 13: Boies does not explicitly disclose the steps of (a) assigning access codes to recipients that are related to recipient's virtual post office box; (b) delivering access codes to recipients; (c) receiving recipient's name, access code and recipient's intention to change their delivery address; and (d) changing recipient's delivery address upon conformation of recipient's name and access code. However, in claim 5 thereof, Boies discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions (see claim 5). Of course, **to keep anonymity and privacy** (see the Abstract of Boies), the use of the claimed steps for changing the delivery address would have been within the level of ordinary skill in the art. More specifically, it would have been obvious to (a) assign access codes (e.g., passwords) to recipients that are related to each recipient's virtual post office box to prevent others from accessing unauthorized post office boxes; (b) deliver access codes to recipients to allow each recipient to access his or her post office box for the desired address change; (c) receive recipient's name, access code and recipient's intention to change their delivery address to update the change of the address; and (d) change recipient's delivery address upon conformation of recipient's name and access code to effect the change of the address.

Re claim 14: Boies does not explicitly disclose the changing step that further includes recipient specifies the time period in which mail is going to be delivered to the changed delivery address. However, it is old and well-known practice to specify the time period in which mail is going to be delivered to the changed delivery address (e.g., when someone is on vacation, it has been a common practice to notify the Post Office to reroute the mail to a next neighbor or hold until the person comes back from the vacation), and nothing unobvious is seen to have been involved simply having employed this old and well-known practice for the claimed method to facilitate the mail delivery.

Re claim 15: Boies does not explicitly disclose the steps of (a) assigning a biometrics to recipients; (b) delivering the biometrics to recipients; (c) receiving recipient's biometrics and recipient's intention to change their delivery address; (d) changing recipient's delivery address upon conformation of recipient's biometrics. However, in claim 5 thereof, Boies discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions (see claim 5). Of course, **to keep anonymity and privacy** (see the Abstract of Boies), the use of the claimed steps for changing the delivery address would have been within the level of ordinary skill in the art. More specifically, it would have been obvious to (a) assign a biometrics (e.g., finger print) to recipients that are related to each recipient's virtual post office box to prevent others from accessing unauthorized post office boxes; (b) deliver the biometrics to recipients to allow each recipient to access his /her post office box for the desired address change; (c) receive recipient's biometrics and recipient's intention to change their delivery address to update the change of the address; and (d) change recipient's delivery address upon conformation of recipient's biometrics to effect the change of the address.

Re claims 16, 17, 18, 19 and 20: Boies does not explicitly disclose that the recipient's name, access code and recipient's intention to change their delivery address may be received by telephone, by facsimile, by computer, in person, or by mail. However, those are well-known

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methods of notifying the changes of personal information, and it would have been common sense to employ any one of the above well-known methods as desired to notify the changes of the personal information (e.g., address, phone number, or etc.) to effect the change of the address.

Re claim 21: Boies does not explicitly disclose that the recipient's access code is encrypted. However, it is a well-known practice in the art to encrypt any vital information in the art to prevent fraudulent access of the personal account or database and it would have been common sense to employ this well-known practice for the claimed method to further enhance the anonymity and privacy (see the Abstract of Boies) of the recipient.

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boies in view of Allum as applied to claim 1 above, and further in view of Allen et al. (Allen hereinafter: US PAT. 5,422,821).

Boies does not explicitly disclose that one of the data bases is the National Name and Address Data Base. However, Allen teaches the use of the National Name and Address Data Base (i.e., US PS National Change of Address database) to identify, intercept and forward incorrectly addressed mail pieces. Thus, it would have been within the level of ordinary skill in the art to further modify the method of Boies modified by Allum by adopting the teaching of Allen to identify, intercept and forward incorrectly addressed mail pieces.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Pwu whose telephone number is 703 308-7835. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 703 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey Pwu



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JEFFREY PWU
PRIMARY EXAMINER